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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,453	06/30/2003	James Harold Gray	36968/332569	1614

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ATLANTA, GA 30309

EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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01/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/611,453	GRAY ET AL.	
	Examiner	Art Unit	
	Jason P. Salce	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-19, 45-50 and 76-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-19, 45-50 and 76-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/19/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 1-13, 20-44, 51-75 and 82-93 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/10/2007. The examiner notes that Applicant is required to cancel any non-elected claims.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 12/19/2007 was filed after the mailing date of the Restriction Requirement on 8/21/2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 76-81 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In regards to claims 76-81, the preamble of each claim states, "A machine readable medium having stored thereon a series of instructions, the instructions, when executed by a processor, cause the processor to". Applicant's specification states at Paragraph 0025, "Embodiments of the present invention may be provided as a computer program product which may include a machine-readable medium having stored thereon instructions which may be used to program a computer (or other electronic devices) to perform a process. The machine-readable medium may include...Moreover, embodiments of the present invention may also be downloaded as a computer program product, wherein the program may be transferred from a remote computer to a requesting computer by way of data signals embodied in a carrier wave or other propagation medium via a communication link".

The specification has not enabled one of ordinary skill in the art to interpret the limitation "machine-readable medium" because the specification states that a computer program product (which includes a machine-readable medium) is downloaded. The examiner notes that a physical disk cannot be downloaded as a transmission signal.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 76-81 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Paragraph 0025 of Applicant's specification states that a computer product program (which includes a machine-readable medium) can be downloaded as a transmission signal (from a remote computer to a requesting computer), which is non-statutory under 35 U.S.C. 101 (see MPEP 2106[R-6] IV B).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-17, 19, 45-48, 50, 76-79 and 81 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Blackketter et al. (U.S. Patent No. 7,237,253).

Referring to claim 14, Blackketter discloses receiving a hot key signal from an interactive television service provider's network (**see step 300 in Figure 9**), the hot key signal indicating availability and location of alternative content (**see Figure 11 for the transmitted table of information (hot key signal) including data that indicates availability and location of alternative content**) and containing data representing a hot key form (**see Figure 11 for the table containing a web address**).

Blackketter discloses determining whether the hot key signal is relevant to a user viewing original content from the interactive television service provider (**see steps 302-310 in Figure 9**).

Blackketter discloses responsive to determining the hot key signal is relevant to the user, displaying on a screen an indication that the hot key signal has been received, the indication corresponding to the data representing the hot key form (**see steps 312-314 in Figure 9**).

Referring to claim 15, Blackketter discloses that the data representing the hot key form indicates one of a plurality of possible hot key forms (**see Figure 11 for the hot key form (web address) being one of a plurality of possible web addresses**).

Referring to claim 16, Blackketter discloses that the data representing the hot key form comprises a graphic (**see Column 7, Lines 30-32**).

Referring to claim 17, Blackketter discloses that the graphic is displayed on the screen as the indication that the hot key signal has been received ().

Referring to claim 19, Blackketter discloses that the graphic is not included in the hot key signal (**see Column 4, Lines 30-46 for the user interface graphics being generated by the interactive television device 108 and further note Figure 11 for**

the hot key signal only containing the data used to determine if an interactive or online mode is available for a television program).

Referring to claims 45-48 and 50, see the rejection of claims 14-17 and 19, respectively.

Referring to claims 76-79 and 81, see the rejection of claims 14-17 and 19, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 49 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blacketter et al. (U.S. Patent No. 7,237,253).

Referring to claim 18, Blacketter discloses all of the claim limitations of claim 1, but fails to teach that the graphic is pre-selected by the user.

The examiner takes Official Notice that a graphics data that can be pre-selected by a user. For example, it is well known in the art for a user to prefer to see a button as opposed to a check box and select the button instead of a check box in accordance with a user's preference.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify receiver software, as taught by Blacketter, to include GUI display preference settings, as taught by the Examiner's Official Notice, for the purpose of providing a user interface that is aesthetically pleasing to a user.

Referring to claims 49 and 80, see the rejection of claim 18.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/611,453
Art Unit: 2623

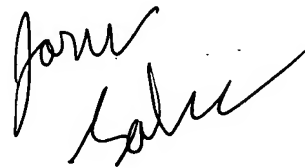
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason P Salce
Primary Examiner
Art Unit 2623

January 8, 2008

JASON SALCE
PRIMARY PATENT EXAMINER

A handwritten signature in black ink, appearing to read "Jason Salce", written over the printed name and title.